UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 December 2009 and 29 September 2009</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-12,14-21 and 23-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-12,14-21 and 23-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 8, 2009 has been entered.

Status

2.   This Office Action is in response to the communications filed on September 29, 2009 and December 8, 2009. Claims 4, 13, and 22 have been cancelled, claims 10, 19, and 23 have been amended, and no claims have been added. Therefore, claims 1-3, 5-12, 14-21, and 23-27 are pending and presented for examination.

Response to Amendment

3.   Summary of the Response to Applicant's Amendment:

- Applicant's amendment canceling claims 4, 13, and 22 overcomes the claim objections to these claims; therefore the Examiner withdraws the respective objections.

- Applicant's amendment overcomes the rejection under 35 USC § 112, second paragraph, of claims 19 and 23; therefore the Examiner withdraws the respective rejections.

- Applicant's amendment overcomes the rejection under 35 USC § 101, particularly due to the phone performing the associating step; therefore the Examiner withdraws the respective rejections.

- The Examiner notes amendment addition and deletions indicated at claim 24 by strike-through and underlining, however, the claim label indicates that this is still an original claim. The Examiner is treating this as an amendment with a minor or informal error rather than a nonconformance issue, but appropriate correction or notation is in order. The Examiner also notes that, if other such errors are present, they have not been noted and will be regarded as an ineffective amendment.

- Applicant's amendments do not overcome the prior art rejections under 35 USC §§ 102 and 103; therefore the Examiner maintains the rejections, but includes further citation and explanation in the rejections below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 recites the term "GUI" at both elements. There is insufficient antecedent basis for this term. For examination purposes, the Examiner will interpret this to mean a graphical user interface. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   **Claims 1, 4-5, 7, 10, 13-14, 16, 19, 22-23, and 25 are rejected under 35**

U.S.C. 102(a) and (e) as being anticipated by Barenbaum et al. (U.S. Patent

Application Publication No. 2001/0039514, hereafter Barenbaum).

Please note that, as a convenience to applicant, the Examiner has pointed out,

by **bolding**, optional or intended use language, and included a note as to the

ramifications of such language below.

Claim 1: Barenbaum discloses a mobile phone having a software application **for**

participating in a promotional offer, said mobile phone comprising:

a processor (paragraph 0042, display the identifier; the Examiner notes that there

must be a processor in order to direct the retaining and displaying; citation hereafter

by number only);

a processor readable storage medium (0042, display the identifier; the Examiner

notes that there must be storage in order to retain for display);

code recorded in the processor readable storage medium **to input** a promotional

offer code into the mobile phone (0010, 0021, 0037, digital deal code and incentives;

the Examiner also understands that phone software enabling a user to input the offer

code (e.g. pressing "1" enters data, and pressing "2" enters different data, etc.) also

satisfies this requirement, and must be present on enabled phones);

code recorded in the processor readable storage medium **to access** promotional

offer code data that has been pre-stored in the mobile phone (0010, 0021, 0026,

0034, 0035; the Examiner understands that once the deal code or incentive is sent

to the phone, it is stored at the phone, thus "pre-stored" before use of the deal code;

the Examiner also understands that phone software enabling a user to access

various menus and/or to display the digital deal satisfies this requirement), the

promotional offer code data comprising parameters of a sponsor of a promotional

campaign that awards prizes to winners of the promotional campaign (0021, 0024,

0026; the Examiner understands the incentive, or offer, or expiration date, as

communicated by the data of the deal, to be parameters of a sponsor, and since

more deals may be conveyed than are available, the winners are those that redeem

the offer of the sponsor);

code recorded in the processor readable storage medium **to associate** an input

promotional offer code with corresponding promotional offer code data (0026,

authenticate redemption; 0034, enable communication; 0037, communicate code to

receive incentive; the Examiner understands that associating the offer code and data

is required in order to communicate a requested deal and also to redeem a deal or

incentive);

code recorded in the processor readable storage medium **to construct** a

promotional offer entry based on promotional offer code data that corresponds to a

promotional offer code (0037, 0025-0026; the Examiner understands a deal request

or a communication of the deal code to a server to require constructing an entry);

and

code recorded in the processor readable storage medium **to transmit** the

promotional offer entry to the sponsor (0037; the Examiner notes that the client is

the sponsor per 0021).

Claim 5: Barenbaum discloses the mobile phone of claim 4 wherein the code

recorded in the processor readable storage medium **to construct** a specific

promotional offer entry comprises:

code recorded in the processor readable storage medium **to create** a message

addressed to the promotional sponsor in the format described by the promotional

offer code data (0037, 0039); and

code recorded in the processor readable storage medium **to include** the content

described by the promotional offer code data in the message (0037, 0039; the

Examiner understands that the digital deal code being sent back with the entry is all

the format and content required for valid entry).

Claim 7: Barenbaum discloses the mobile phone of claim 5 wherein the format of the promotional offer entry described by the promotional offer code data is an SMS message (0037, short messaging service).

Claim 10: Barenbaum discloses a method **operable on** a mobile phone that **allows** the mobile phone **to participate** in a promotional offer, said method comprising:

receiving by the mobile phone a promotional offer code (0010, 0021, 0037, digital deal code and incentives);

accessing, by the mobile phone, promotional offer code data that has been pre-stored in the mobile phone (0010, 0021, 0026, 0034, 0035; the Examiner understands that once the deal code or incentive is sent to the phone, it is stored at the phone, thus "pre-stored" before use of the deal code; the Examiner also understands that phone software enabling a user to access various menus and/or to display the digital deal satisfies this requirement), the promotional offer code data comprising parameters of a sponsor of a promotional campaign that awards prizes to winners of the promotional campaign (0021, 0024, 0026; the Examiner understands the incentive, or offer, or expiration date, as communicated by the data of the deal, to be parameters of a sponsor, and since more deals may be conveyed than are available, the winners are those that redeem the offer of the sponsor);

associating, by the mobile phone, an input promotional offer code with corresponding promotional offer code data (0026, authenticate redemption; 0034, enable communication; 0037, communicate code to receive incentive; the Examiner

understands that associating the offer code and data by the phone is required in order to communicate a requested deal and also to redeem a deal or incentive);

constructing, by the mobile phone, a promotional offer entry based on promotional offer code data that corresponds to a promotional offer code (0037, 0025-0026; the Examiner understands a deal request or a communication of the deal code to a server to require constructing an entry); and

transmitting, by the mobile phone, the promotional offer entry to a promotional sponsor (0037; the Examiner notes that the client is the sponsor per 0021).

Claim 14: Barenbaum discloses the method of claim 13 wherein constructing a specific promotional offer entry comprises:

creating, by the mobile phone, a message addressed to the promotional sponsor in the format described by the promotional offer code data (0037, 0039); and

including, by the mobile phone, the content described by the promotional offer code data in the message (0037, 0039; the Examiner understands that the digital deal code being sent back with the entry is all the format and content required for valid entry).

Claim 16: Barenbaum discloses the method of claim 14 wherein the format of the promotional offer entry described by the promotional offer code data is an SMS message (0037, short messaging service).

Claim 19: Barenbaum discloses a mobile phone **for participating** in a promotional offer, said mobile phone comprising:

a radio frequency (RF) module configured to receive a promotional offer code

into the mobile phone (0010-0011, 0021, 0037, digital deal code and incentives; the

Examiner understands the wireless device, specifically such as in the case of a

phone, to use and include a radio frequency module);

a processor configured to access promotional offer code data that has been pre-

stored in the mobile phone (0010, 0021, 0026, 0034, 0035; the Examiner

understands that once the deal code or incentive is sent to the phone, it is stored at

the phone, thus "pre-stored" before use of the deal code; the Examiner also

understands that phone software enabling a user to access various menus and/or to

display the digital deal indicates a processor accessing the data), the promotional

offer code data comprising parameters of a sponsor of a promotional campaign that

awards prizes to winners of the promotional campaign (0021, 0024, 0026; the

Examiner understands the incentive, or offer, or expiration date, as communicated

by the data of the deal, to be parameters of a sponsor, and since more deals may be

conveyed than are available, the winners are those that redeem the offer of the

sponsor), the processor further configured to associate the received promotion offer

code with corresponding pre-stored promotional offer code data (0026, authenticate

redemption; 0034, enable communication; 0037, communicate code to receive

incentive; the Examiner understands that associating the offer code and data by the

phone is required in order to communicate a requested deal and also to redeem a

deal or incentive); and

a graphical user interface configured to allow constructing a promotional offer

entry based on promotional offer code data that corresponds to a promotional offer

code (0037, 0025-0026; the Examiner understands a deal request or a

communication of the deal code to a server to require constructing an entry and that

this is done through a graphical user interface), the RF module transmitting the

specific promotional offer entry to a promotional sponsor (0037).

Claim 23: Barenbaum discloses the mobile phone of claim 19 wherein allowing

constructing the promotional offer entry comprises:

the GUI allowing creating a message addressed to the promotional sponsor in

the format described by the promotional offer code data (0025-0026, 0037, 0039);

and

the GUI allowing including the content described by the promotional offer code

data in the message (0025-0026, 0037, 0039; the Examiner understands that the

digital deal code being sent back with the entry is all the format and content required

for valid entry).

Claim 25: Barenbaum discloses the mobile phone of claim 23 wherein the format

of the promotional offer entry described by the promotional offer code data is an

SMS message (0037, short messaging service).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 2-3, 6, 8-9, 11-12, 15, 17-18, 20-21, 24, and 26-27 are rejected under

35 U.S.C. 103(a) as being unpatentable over Barenbaum.

Claim 2: Barenbaum discloses the mobile phone of claim 1 wherein the pre-

stored promotional offer code data that resides in the mobile phone was sent to the

mobile phone via an over-the-air (OTA) process. Barenbaum, however, teaches

providing device address (0010), mobile numbers (0034), and client input data

(0035) as identifiers, and the Examiner understands that the address and numbers

are generally flashed or placed in memory when the phone is activated, and the

client input data would generally be part of the initial offer information sent via

wireless communication to the user. The Examiner understands that providing the

promotional offer code data via an OTA process or manufacturer embedding are

each one of but a limited number of predictable ways to provide the data to the

mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to combine the promotional offer data of Barenbaum with the client

input data of Barenbaum in order to provide the data to the mobile phone via an

OTA process.

The rationale for combining in this manner is that OTA provision is one of a

limited number of predictable ways of providing the promotion offer code data to the

mobile phone.

Claim 3: Barenbaum discloses the mobile phone of claim 1, but does not

explicitly disclose wherein the pre-stored promotional offer code data that resides in

the mobile phone was embedded into the mobile phone by the manufacturer.

Barenbaum, however, teaches providing device address (0010), mobile numbers

(0034), and client input data (0035) as identifiers, and the Examiner understands

that the address and numbers are generally flashed or placed in memory when the

phone is activated, and the client input data would generally be part of the initial offer

information sent via wireless communication to the user. The Examiner understands

that providing the promotional offer code data via an OTA process or manufacturer

embedding are each one of but a limited number of predictable ways to provide the

data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to combine the promotional offer data of Barenbaum with the client

input data of Barenbaum in order to provide the data to the mobile phone via a

manufacturer embedding process.

The rationale for combining in this manner is that manufacturer embedding is one

of a limited number of predictable ways of providing the promotion offer code data to

the mobile phone.

Claim 6: Barenbaum discloses the mobile phone of claim 5, but does not

explicitly disclose wherein the code recorded in the processor readable storage

medium to construct a specific promotional offer entry further comprises: code

recorded in the processor readable storage medium to encrypt the message.

Barenbaum, however, teaches assigning a unique identifier or authorization code to

each digital deal in order to track and verify the deals (0039). The Examiner

understands encrypting to be a means of verification and assuring privacy, therefore

it is a design choice as whether to encrypt and/or to use unique identifiers to either assure privacy or verify identities or deals offered.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the unique identifier and authorization code of Barenbaum in order to encrypt the promotional offer entry message.

The rationale for combining in this manner is that using encryption is a design choice regarding verification and privacy.

Claim 8: Barenbaum discloses the mobile phone of claim 5, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an MMS message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an MMS message.

The rationale for combining in this manner is that MMS is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 9: Barenbaum discloses the mobile phone of claim 5, but does not

explicitly disclose wherein the format of the promotional offer entry described by the

promotional offer code data is an e-mail message. Barenbaum, however, teaches

text and short message service entry (0037), responses that may include logos

(0028, 0042) and bar codes (0039), and email alerts (0023) as communication

types. The Examiner understands that SMS, MMS and e-mail are each one of but a

limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to combine the mobile phone promotional offer of Barenbaum with

the various types of communications of Barenbaum in order to provide the

promotional offer entry to be an e-mail message.

The rationale for combining in this manner is that e-mail is but one of a limited

number of predictable types of communication when using a mobile phone.

Claim 11: Barenbaum discloses the method of claim 10, but does not explicitly

disclose wherein the pre-stored promotional offer code data that resides in the

mobile phone was sent to the mobile phone via an over-the-air (OTA) process.

Barenbaum, however, teaches providing device address (0010), mobile numbers

(0034), and client input data (0035) as identifiers, and the Examiner understands

that the address and numbers are generally flashed or placed in memory when the

phone is activated, and the client input data would generally be part of the initial offer

information sent via wireless communication to the user. The Examiner understands

that providing the promotional offer code data via an OTA process or manufacturer

embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via an OTA process.

The rationale for combining in this manner is that OTA provision is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 12: Barenbaum discloses the method of claim 10, but does not explicitly disclose wherein the pre-stored promotional offer code data that resides in the mobile phone was embedded into the mobile phone by a manufacturer of the mobile phone. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client

input data of Barenbaum in order to provide the data to the mobile phone via a

manufacturer embedding process.

The rationale for combining in this manner is that manufacturer embedding is one

of a limited number of predictable ways of providing the promotion offer code data to

the mobile phone.

Claim 15: Barenbaum discloses the method of claim 14 wherein constructing a

specific promotional offer entry further comprises encrypting the message.

Barenbaum, however, teaches assigning a unique identifier or authorization code to

each digital deal in order to track and verify the deals (0039). The Examiner

understands encrypting to be a means of verification and assuring privacy, therefore

it is a design choice as whether to encrypt and/or to use unique identifiers to either

assure privacy or verify identities or deals offered.

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to combine the promotional offer data of Barenbaum with the unique

identifier and authorization code of Barenbaum in order to encrypt the promotional

offer entry message.

The rationale for combining in this manner is that using encryption is a design

choice regarding verification and privacy.

Claim 17: Barenbaum discloses the method of claim 14, but does not explicitly

disclose wherein the format of the promotional offer entry described by the

promotional offer code data is an MMS message. Barenbaum, however, teaches

text and short message service entry (0037), responses that may include logos

(0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an MMS message.

The rationale for combining in this manner is that MMS is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 18: Barenbaum discloses the method of claim 14, but does not explicitly disclose wherein the format of the promotional offer entry described by the promotional offer code data is an e-mail message. Barenbaum, however, teaches text and short message service entry (0037), responses that may include logos (0028, 0042) and bar codes (0039), and email alerts (0023) as communication types. The Examiner understands that SMS, MMS and e-mail are each one of but a limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the mobile phone promotional offer of Barenbaum with the various types of communications of Barenbaum in order to provide the promotional offer entry to be an e-mail message.

The rationale for combining in this manner is that e-mail is but one of a limited number of predictable types of communication when using a mobile phone.

Claim 20: Barenbaum discloses the mobile phone of claim 19, but does not explicitly disclose wherein the pre-stored promotional offer code data that resides in the mobile phone was sent to the mobile phone via an over-the-air (OTA) process. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via an OTA process.

The rationale for combining in this manner is that OTA provision is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 21: Barenbaum discloses the mobile phone of claim 19, but does not explicitly disclose wherein the pre-stored promotional offer code data that resides in the mobile phone was embedded into the mobile phone by the manufacturer. Barenbaum, however, teaches providing device address (0010), mobile numbers (0034), and client input data (0035) as identifiers, and the Examiner understands

that the address and numbers are generally flashed or placed in memory when the phone is activated, and the client input data would generally be part of the initial offer information sent via wireless communication to the user. The Examiner understands that providing the promotional offer code data via an OTA process or manufacturer embedding are each one of but a limited number of predictable ways to provide the data to the mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the client input data of Barenbaum in order to provide the data to the mobile phone via a manufacturer embedding process.

The rationale for combining in this manner is that manufacturer embedding is one of a limited number of predictable ways of providing the promotion offer code data to the mobile phone.

Claim 24: Barenbaum discloses the mobile phone of claim 23, but does not explicitly disclose wherein constructing the promotional offer entry further comprises encrypting the message. Barenbaum, however, teaches assigning a unique identifier or authorization code to each digital deal in order to track and verify the deals (0039). The Examiner understands encrypting to be a means of verification and assuring privacy, therefore it is a design choice as whether to encrypt and/or to use unique identifiers to either assure privacy or verify identities or deals offered.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional offer data of Barenbaum with the unique

identifier and authorization code of Barenbaum in order to encrypt the promotional

offer entry message.

The rationale for combining in this manner is that using encryption is a design

choice regarding verification and privacy.

Claim 26: Barenbaum discloses the mobile phone of claim 23, but does not

explicitly disclose wherein the format of the promotional offer entry described by the

promotional offer code data is an MMS message. Barenbaum, however, teaches

text and short message service entry (0037), responses that may include logos

(0028, 0042) and bar codes (0039), and email alerts (0023) as communication

types. The Examiner understands that SMS, MMS and e-mail are each one of but a

limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to combine the mobile phone promotional offer of Barenbaum with

the various types of communications of Barenbaum in order to provide the

promotional offer entry to be an MMS message.

The rationale for combining in this manner is that MMS is but one of a limited

number of predictable types of communication when using a mobile phone.

Claim 27: Barenbaum discloses the mobile phone of claim 23, but does not

explicitly disclose wherein the format of the promotional offer entry described by the

promotional offer code data is an e-mail message. Barenbaum, however, teaches

text and short message service entry (0037), responses that may include logos

(0028, 0042) and bar codes (0039), and email alerts (0023) as communication

types. The Examiner understands that SMS, MMS and e-mail are each one of but a

limited number of ways to accomplish communication via a mobile phone.

Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to combine the mobile phone promotional offer of Barenbaum with

the various types of communications of Barenbaum in order to provide the

promotional offer entry to be an e-mail message.

The rationale for combining in this manner is that e-mail is but one of a limited

number of predictable types of communication when using a mobile phone.

7.   A recitation of the intended use of the claimed invention must result in a

structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art

structure is capable of performing the intended use, it meets the claim. See *e.g. In

re Collier,* 158 USPQ 266, 267 (CCPA 1968) (where the court interpreted the

claimed phrase "a connector member for engaging shield means" and held that the

shield means was not a positive element of the claim since "[t]here is no positive

inclusion of 'shield means' in what is apparently intended to be a claim to structure

consisting of a combination of elements" and where the court interpreted the claimed

phrase "said ferrule-forming member being crimpable onto said shield means" and

held that the shield means was not a positive element of the claim since "[t]here is

no positive inclusion of 'shield means' in what is apparently intended to be a claim to

structure consisting of a combination of elements.... "[t]he ferrule or connector

member is crimpable but not required, structurally, to be crimped .... These cannot

be regarded as structural limitations and therefore not as positive limitations in a

claim directed to structure. They cannot therefore be relied on to distinguish from the

prior art.")

The Examiner has analyzed the claim language and phrasing as indicated by the

bold sections or words above, and determined that the phrasing following the

bolded word(s) is not required due to the terminology being optional or intended use

or expected results, in conformity with MPEP § 2111.04.

Response to Arguments

8.   Applicant's arguments with respect to the prior art rejections of claims 1, 10, and

19 have been fully considered, but are generally directed to claim limitations that are

not reflected in the current claim phrasing, therefore the arguments are not

persuasive.

Applicant argues that Barenbaum does not disclose promotional offer code data

pre-stored on the phone and comprising sponsor parameters of a campaign. The

Examiner notes that the current claim phrasing, particularly or especially at claims 1

and 19, does not require data to be pre-stored on the phone – claim 1 recites code,

and claim a processor configured, to access promotional code data, but the phrasing

does not that the data be pre-stored, only that it is capable of accessing that data if

that data were, or is, present: the claim element is directed to the code or processor,

not to the data storage. Therefore, also, what the promotional offer code data is

comprised of is fairly immaterial since it is not required to be pre-stored.

The Examiner is uncertain if Applicant is viewing or interpreting promotional offer

code data in a more narrow sense, but that appears to be the case in light of

Applicant's arguments. The Examiner understands that promotional offer code data

is any data regarding code, or a code, related to a promotional offer, and also that

promotional offer code data does not indicate the offer itself, but rather reflects

almost any related data – as an example, Applicant admits (Remarks, page 8 of 10)

that Barenbaum identifies potential customers based on profile data and that

incentives are determined. Since an incentive is a promotion (an incentive promotes

a product or service), an incentive offer is a promotional offer, and then code data

that is used to offer the incentive (such as identifying a customer) is promotional

offer code data.

Even if one deems the pre-storing of promotional offer code data to be required

(perhaps at least better reflected by claim 10) and that the data comprises sponsor

parameters, when one considers that sponsor parameters may be (and commonly

are) customer identifications (e.g. member of a program, owner or user of a phone

or other device, meeting a demographic constraint, etc.) then Barenbaum discloses

the claim elements since "pre-storing" only limits by indicating that the data is stored

on the phone prior to use (i.e. the "pre-storing" is not limited to prior to sale of the

phone, or prior to any other event, in light of claim 2 limitations indicating being able

to be sent over the air – therefore, obviously, being able to be sent any time prior to

use of the data). For example, if an incentive promotion exists where the sponsor is

willing to offer a discount (perhaps a discount on a per minute rate charge for mobile

phone usage) to owners or users of a particular model phone (or users that meet a

particular demographic, such as being 16-25 years old), then Barenbaum allows the

phone to receive that offer, access the profile data and send that data to the offeror.

Applicant does not appear to indicate, in the Remarks, why Applicant believes

Barenbaum does not disclose the claimed invention; rather Applicant repeatedly

asserts that Barenbaum is different from the claimed invention - amounting to a bare

assertion of patentability.

Therefore, the Examiner is not persuaded by Applicant's arguments.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to SCOTT D. GARTLAND whose telephone number is

571-270-5501. The examiner can normally be reached on 7:30-6:00 EST Monday to

Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-

8300.

Information regarding the status of an application may be obtained from the

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assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-

272-1000.

/S. D. G./
Examiner, Art Unit 3622

/John Van Bramer/
John Van Bramer
Primary Examiner, Art Unit 3622